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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,225	09/29/1999	BERND BRETSCHNEIDER	60680-1281	4893

10291 7590 11/17/2003

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EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/17/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/341225

Applicant(s)

Bretschneider et al

Examiner

D Loney

Group Art Unit

1772

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 29-31, 33-49, 51-59 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 29-31, 33-49, 51-59 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 21, 2002 has been entered.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 29-31 and 33-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6279229 in view of Yoneno et al.

The primary reference is substantially similar to the instant claims except for the specific insulating material being reacted in the claims.

Yoneno et al discloses that flaky perlite be used as the insulating material within a heat shield. Refer to the Abstract and Fig. No. 1.

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Therefore, it would have been obvious to one having ordinary skill in the art to use perlite as the insulator, as taught by Yoneno et al since the primary reference teaches an insulative material within the heat shield and perlite is known to be an used as an enclosed heat shield insulative material.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 29-31, 33-38, 42, 44-49, 51, 52 and 56-59 are rejected under 35

U.S.C. 102(b) as being anticipated by Sextl et al.

Sextl et al discloses a metal encased powder mica and/or perlite used for heat shields. Refer to column 3, lines 26-50, and column 5, and lines 40 and 41, column 6 lines 16 and 17 and column 7. lines 5, 6, 35 and 36 along with the Figure.

7. Claim 29, 30, 31, 33, 34, 38, 44, 45, 49, 51, 52, 56 and 57 are rejected under 35

U.S.C. 102(b) as being anticipated by Kawasaki et al.

Kawaski et al discloses an evacuated heat shield that has metal within both face sheets and prelate inside. A metal layer (42) can be located on the out side, meeting instant claims 56 and 57. Refer to Fig. Nos. 3-5 and 7-10 along with column 2, lines 34-69, column 3, lines 8-39 and column 4, lines 16-41

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8. Claims 29, 30, 31, 38, 43, 44, 49, 51, 52, 53, 54, 58 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson.

Jackson discloses a heat shield containing particles of perlite. The outer surface can be indented (15). There are also sections (4, 4a) that do not contain insulation.

Refer to Fig. Nos. 2, 3, 5 along with column 2, lines 36-60.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 39, 40, 41, 47, 48 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson.

Jackson teaches the invention substantially as reacted except for the trough, charge and roughness limitations. Jackson does teach that any shape can be formed. See column 3, lines 31-52.

Therefore it would have been obvious to one having ordinary skill in the art to form the shield into a trough shape in order to conform to desired components needed to be insulated since Jackson teaches any shape can be formed. The limitations to the charge and roughness would be obvious to one of skill in the art motivated by the fact that it would aid in maintaining the position of the shield when put in place.

Any inquiry concerning this communication should be directed to D. Loney at telephone number 703-308-2416.

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D. Loney/lap

November 10, 2003

A handwritten signature in black ink, appearing to read "D. Loney", with a stylized flourish at the end.

DONALD J. LONEY
PRIMARY EXAMINER